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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,147	08/08/2001	Robert Bible JR.	11298.4.1	3521

7590 05/07/2004

Attn: NEIL K. NYDEGGER
NYDEGGER & ASSOCIATES
348 Olive Street
San Diego, CA 92103

EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,147

Applicant(s)

BIBLE ET AL

Examiner

Jalatee Worjloh

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My

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-16 is/are rejected.
- 7) ☒ Claim(s) 2-6 and 17-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 have been examined.

Information Disclosure Statement

2. Although the IDS references were considered, Applicant is required to submit an appropriate PTO Form 1449, so the examiner may initial.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101, is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 8 and 9 recite the limitation " said step of decrypting" in line1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2002/0112171 to Ginter et al.

Ginter et al. disclose creating said file, with said file having a first part (i.e. "permission record/PERC") and a second part, i.e. "content", (see paragraph [2218]), encrypting said first part of said file with a first private key (see paragraph [1058], lines 20-22), wherein said first part of said file includes a second private key (see paragraph [1194]), encrypting said second part of said file with said second private key (see paragraph [1289], lines 52-55). Ginter et al. teach the first part contains "decryption keys" and "any other keys" for encoding and/or decoding; thus, the examiner notes that "any other keys" can include the second private key. As for encrypting the second part, Ginter et al.'s first part contains private body keys and/or rights key

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for encrypting the second part (see paragraph [1289], lines 52-55). At the time the invention was made, it would have been obvious to a person of ordinary skill in to develop the method of Ginter et al. One of ordinary skill in the art would have been motivated to do this because it provides additional security and prevents unauthorized individuals from viewing the content.

Referring to claim 7, Ginter et al. disclose said first private key and second key are provided by the seller (see paragraph [0137]).

Referring to claim 10, Ginter et al. disclose the second part is a content, and further wherein said content includes work selected form a group consisting of books, documents, pamphlets, movies, songs, games, pictures and software (see paragraph [1085], lines 1-10).

9. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6226618 to Downs et al. in view of US Publication No. 2003/0144963 to Saito.

Downs et al. disclose a means for use by a seller (i.e. "content provider") for creating an Internet file (i.e. "Content SC"), said file having a first part (i.e. "metadata") containing administrative information about said file and a second part (i.e. "content") including transactional subject mater, a first private key (i.e. "symmetric key") for encrypting said first part, i.e. "metadata" (see col. 18 table, steps 121-127). Downs et al. do not expressly disclose a second private key for encrypting said second part and a means for releasing said second key for use in decrypting said second part to reveal said content to a buyer. Saito discloses a second private key (i.e. "second secret-key Ks2") for encrypting said second part (i.e. "data"), and a means for releasing said second key for use in decrypting said second part to reveal said content (see paragraph [0062]). At the time the invention was made, it would have been obvious to a

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person of ordinary skill in the art to modify the system disclose by Downs et al. to include a second private key for encrypting said second part and a means for releasing said second key for use in decrypting said second part to reveal said content to a buyer. One of ordinary skill in the art would have been motivated to do this because it provides additional data security and prevent unauthorized individuals from viewing the content.

Referring to claim 12, Downs et al. do not expressly disclose the second private key is provided by the seller. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The creating, encrypting and decrypting steps would be performed the same regardless of the key provider. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *in re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the seller or any other entity to provide the private key because this process does not functionally relate to the steps in the system.

Referring to claim 13, Downs et al. disclose the first key is provided by a transaction agent, i.e. "clearinghouse" (see col. 19 table, steps 144 and 145).

Referring to claim 14, Downs et al. disclose a buyer's account maintained by a transaction agent for the buyer, a seller's account maintained by the transaction agent for the seller, and a means for transferring funds of said value from the buyer's account to the seller's account when said second part of said file is revealed (col. 11, lines 15-27; col. 19 table, steps 137 & 138).

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. and Saito as applied to claim 11 above, and further in view of Ginter et al.

Downs et al. disclose content of said second part includes work selected from a group consisting of books, documents, pamphlets, movies, songs, games, pictures and software (see col. 6, lines 45-84; col. 18 table, step 136). Downs et al. do not expressly disclose a clear-text header, with said header including advertising material and commercial material about said file. Ginter et al. disclose a clear-text header, with said header including advertising material and commercial material about said file (see paragraph [2170]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Downs et al. to include a clear-text header, with said header including advertising material and commercial material about said file. One of ordinary skill in the art would have been motivated to do this because it provides detail information that may be necessary to the buyer.

Allowable Subject Matter

11. Claims 2-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (**specifically, claim 2**).

12. Claims 17-20 would be allowable if, claim 17 is rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 and 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

April 29, 2004